

REMARKS

This paper is filed in response to the Office Action mailed January 7, 2009.

Claims 45-58 are currently pending in this application. Claims 45-58 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent Publication No. 2002/0203025 to Murzanski et al ("Murzanski") in view of U.S. Patent No. 6,346,025 to Tachau et al ("Tachau").

Applicant traverses the Examiner's rejection of the claims and respectfully requests reconsideration and allowance of all claims in light of the remarks below.

I. § 103(a) – Murzanski in view of Tachau – Claims 45 – 58

Applicant respectfully traverses the rejection of claims 45-58 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Murzanski in view of Tachau.

To sustain a rejection of a claim under 35 U.S.C. § 103(a), the scope and content of the prior art must disclose or suggest the claimed invention. *See* M.P.E.P. § 2141, 2143.

In the current Office Action, the Examiner asserts that an Applicant may not overcome an obviousness rejection by attacking the references individually.¹ Respectfully, Applicant's arguments showed that neither reference disclosed or suggested an element of the rejection independent claim. In order for the Office meet its burden of presenting a prima facie case of obviousness, the Office must show that the cited references disclose or suggest each and every element of the claimed invention. Because neither of the references alone nor the references in combination show a claimed element or suggest the use of the claimed element, the prima facie case of obviousness is rebutted. The two Federal Circuit cases² cited in the Office Action do not suggest that an argument against an obviousness rejection is improper if a common deficiency is shown in each. Rather, the courts in *Keller* and *Merck* simply point out that the Applicant only addressed the teachings of one of the references, but did not consider what was taught by the art as a

¹ See Office Action, p. 4.

² *In re Keller*, 642 F.2d 413 (Fed. Cir. 1981); *In re Merck*, 800 F.2d 1091 (Fed. Cir. 1986).

whole. In contrast, the Applicant shows that each reference has a common deficiency and that the combination of the two references does not cure this deficiency.

Because the combination of Murzanski in view of Tachau does not disclose or suggest “a plurality of actuators coupled to said housing, said plurality of actuators corresponding to a plurality of sensors on said remotely-controlled device and operable to output a haptic sensation to at least one of said housing or said manipulandum” as recited in claim 45, claim 45 is patentable over Murzanski in view of Tachau.

Murzanski teaches a controller for an electronic gaming system. The controller in Murzanski includes an actuator for outputting forces. However, the controller is configured to be connected to an electronic gaming system. Such a system is not disclosed to have sensors to sense its state. Rather, forces are output to correspond to events occurring in a video game executed by the gaming system. The gaming system does not employ sensors to detect changes of state in the video game, but rather the changes in state are determined by the execution of the gaming software. As such, because Murzanski does not disclose or suggest a plurality of sensors, it cannot disclose that actuators may correspond to the plurality of sensors. Further, because the use of sensors in the electronic gaming system is not contemplated by Murzanski, it cannot fairly be said to suggest the use of actuators corresponding to the sensors.

The addition of Tachau’s teachings to the teachings of Murzanski does not cure the lack of disclosure or suggestion of “a plurality of actuators coupled to said housing, said plurality of actuators corresponding to a plurality of sensors on said remotely-controlled device and operable to output a haptic sensation to at least one of said housing or said manipulandum” as recited in claim 45. In addition to the teachings of Murzanski, Tachau teaches toys that include sensors and actuators, and that may be controlled using a remote control device. However, Tachau does not disclose that a plurality of actuators correspond with a plurality of sensors. Tachau only discloses that an actuator may be activated if an event is sensed, which is not the same as “a plurality of actuators corresponding to a plurality of sensors.”

Thus, because Murzanski does not disclose or suggest the use of sensors at all, and Tachau does not teach a plurality of actuators corresponding to a plurality of sensors, the combined scope of the two references cannot teach “a plurality of actuators coupled

to said housing, said plurality of actuators corresponding to a plurality of sensors on said remotely-controlled device and operable to output a haptic sensation to at least one of said housing or said manipulandum” as recited in claim 45. Therefore, claim 45 is patentable over the combined references. Applicant respectfully requests the Examiner withdraw the rejection of claim 45.

Because claims 46-58 depend from and further limit claim 45, claims 46-58 are each patentable over Murzanski in view of Tachau for at least the same reasons. Applicant respectfully requests the Examiner withdraw the rejection of claims 46-58.

CONCLUSION

Applicant respectfully asserts that in view of the amendments and remarks above, all pending claims are allowable and Applicant respectfully requests the allowance of all claims.

Should the Examiner have any comments, questions, or suggestions of a nature necessary to expedite the prosecution of the application, or to place the case in condition for allowance, the Examiner is courteously requested to telephone the undersigned at the number listed below.

Date:

3/9/2009

Respectfully submitted,



Carl Sanders
Reg. No. 57,203

KILPATRICK STOCKTON LLP
1001 West Fourth Street
Winston-Salem, NC 27101
(336) 607-7474 (voice)
(336) 734-2629 (fax)